

**REMARKS**

Claims 1-19 are all the claims pending in the application.

**Preliminary Matters**

Applicants thank the Examiner for considering the Information Disclosure Statements filed May 21, 2004, August 30, 2004, and August 3, 2005. Applicants also thank the Examiner for acknowledging the claim for foreign priority under 35 U.S.C. § 119. However, the Examiner has not indicated whether the Formal Drawings filed January 26, 2004 are accepted, Applicants respectfully request that the Examiner make this indication.

**Allowable Subject Matter**

The Examiner has indicated that claims 2-12 are allowed. Additionally, claim 14 is objected to as being dependent upon a rejected base claim, but would be allowed if rewritten in independent form. However, instead of rewriting claim 14 in independent form, Applicants hold such rewriting in abeyance, instead choosing to traverse the prior art rejection for the reasons set forth below.

**Claim Rejection - 35 U.S.C. § 103(a)**

The Examiner rejected claims 1, 13 and 15-19 under 35 U.S.C. § 103(a) as being unpatentable over Goldstein (US 5,410,326).

The Examiner applies Goldstein, alleging that it teaches or suggests most of the recitations of claims 1, 13, and 15-19. However, the Examiner concedes that Goldstein does not specifically disclose a "second mode" as claimed. To make up this deficiency, the Examiner makes the following conclusory statement:

Since the device of Goldstein is a universal remote control to control the audio/video devices and to allow navigation of the device

information, it would be obvious to the skilled artisan to recognize that the device of Goldstein does also have the second mode in which the device information displayed on the display unit is navigated in order to select the information for one or more desired devices. (Office Action, pg. 2).

Because this statement appears to be an indication that the “second mode” was inherent in Goldstein, thus constituting a § 102 type rejection, Applicants contacted the Examiner to clarify his statement. The Examiner indicated that the portion of the statement, “it would have been obvious to the skilled artisan to recognize that the device of Goldstein does also have the second mode,” should have been, “it would have been obvious to the skilled artisan to modify the device of Goldstein to have a second mode.”

Thus, based on the Examiner’s clarification, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. First, “to establish *prima facie* obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981 (CCPA 1974). Second, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Here, the Examiner has failed to provide a reference that discloses a second mode as recited in the rejected claims. Thus, we would ask that the Examiner provide us with a reference that actually discloses a second mode.

Additionally, the Examiner seems to allege that the motivation to provide a second mode is so that the device information displayed on the display unit is navigated in order to select the

information for one or more desired devices. However, this motivation comes from the Application's disclosure, and is not anywhere taught or suggested in Goldstein.

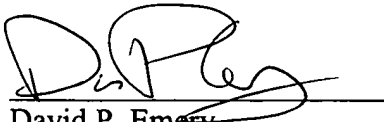
Therefore, because the Examiner has failed to provide: (1) a reference disclosing a second mode; and (2) a teaching or suggestion to combine a second mode with Goldstein, in a reference other than the current application's disclosure, we think that Goldstein fails to render obvious claims 1, 13, and 15-19, for at least these reasons.

**Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
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